



Paper No. 5

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OFFICE OF PETITIONS

In re Application of :
Michael Yeung, Brad Emerson, :
Peter Tran and Louis Ormond :
Application No. 10/054,513 :
Filed: November 13, 2001 :
Attorney Docket No. 66329/07257 :
Title: METHOD AND SYSTEM FOR :
WIRELESS INTERFACING OF ELECTRONIC :
DEVICES :

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

This is in response to the "Response to Notice of Missing Parts," filed August 21, 2002, which is properly treated as a Petition under § 1.47 to accept a declaration without the signatures of all inventors.

The petition is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on November 13, 2001, without an executed oath or declaration. Michael Yeung, Brad Emerson, Peter Tran and Louis Ormond were named as joint inventors. Accordingly, on February 21, 2002, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)," requiring an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply with extensions of time obtainable under § 1.136(a).

In response, applicants filed a declaration executed by joint inventors Yeung, Tran and Ormond on behalf of themselves and on behalf of nonsigning joint inventor Emerson; the surcharge under § 1.16(e); and the instant petition under § 1.47(a) (and fee). This response was made timely by an accompanying petition for a four-month extension of time for response (and fee). Applicants assert that status under § 1.47(a) is proper because inventor Emerson cannot be found or reached to join in the application. In support thereof, petitioners submitted a copy of a letter sent to inventor Emerson via certified mail return receipt requested.

The petition included neither a copy of the certified mail receipt nor a statement of facts by a person with firsthand knowledge, setting forth the facts relied on to conclude that inventor Emerson could not be found or reached, after diligent effort, to join in the application.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (1).

Rule 47 applicants have not provided adequate proof that a diligent effort has been made to reach inventor Emerson. The petition does not include a statement of facts by a person with firsthand knowledge, setting forth the facts relied on to conclude that diligent efforts were made to reach or find inventor Emerson. Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as Internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts.

The proof submitted, a letter, is not adequate. The letter submitted shows that the effort to locate inventor Emerson included mailing a letter to inventor Emerson at his last known address, requesting that he sign the declaration. Petitioners do not include a copy of a certified mail return receipt showing that the letter went "unclaimed." However, given their argument, it is presumed that this is their contention. Yet, being unsuccessful in mailing the application papers to inventor Emerson at his last known address, there is no indication that Rule 47 applicants attempted to determine inventor Emerson's forwarding address, and to send the application papers to that address for consideration by inventor Emerson. See MPEP 409.03(d). If attempts to obtain a forwarding address or to locate the non-signing inventor by other means such as through E-mail, telephone, or the Internet continue to fail, then applicants will have provided the necessary proof required under 37 CFR 1.47 that the inventor cannot be reached or found. Applicant should also submit documentary evidence such as the results of any E-mail or Internet search.

Petitioners are further advised that if inventor Emerson is located but refuses to join in the application, status under § 1.47 for refusal requires a showing that a *bona fide* attempt

was made to present all of the application papers (specification, claims, drawings and oath or declaration) to the nonsigning inventor for signature. The letter submitted on instant petition would not be adequate for such purpose as it only supports a conclusion that applicants attempted to present the declaration and assignment to inventor Emerson.

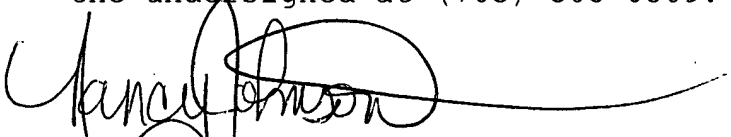
Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0309.

A handwritten signature in dark ink, appearing to read "Nancy Johnson", with a long horizontal flourish extending to the right.

Nancy Johnson
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy